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10/015,314	12/11/2001	David Allen Loewenstein	FERN-P008	2903

7590 05/03/2005  
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EXAMINER

RADA, ALEX P

ART UNIT PAPER NUMBER

3714

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/015,314

Applicant(s)

LOEWENSTEIN, DAVID ALLEN

Examiner

Alex P. Rada

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14, 17-19, 23, 26 and 27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14, 17-19, 23, and 26-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION*****Response to Amendment***

In response to the amendment filed February 3, 2005 in which the applicant cancels claims 15, 20-22, 24-25, amends claims 1-9 and 17-19, adds new claims 26-27, and claims 1-14, 17-19, 23, and 26-27 are pending in this application.

***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the flowchart of method claims 1-9, 17-19, 23, and 26-27 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

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be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

*Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 26 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filed does disclose nor enable the player performing additional exchanges of the previously exchanged cards to a third or forth hand. The specification only discloses in paragraph 8, the player exchanging opposing cards. The examiner request applicant to point in the disclosure the claimed subject matter.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 26 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 27 is recites the limitation 'the swaps' in line 5. There is insufficient antecedent basis for this limitation in the claim.

*Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-6, 8-12, 14, 17-19, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marks et al. (US 5,882,260) in view of Wood et al. (US 6,471,587).

8. Marks et al discloses the following:

Dealing cards in a four sided shape (columns 89 and 90) each side is a separate hand that has five cards, three interior cards and two corner cards, the corner cards are shared with two adjacent hands, and the resulting hands are compared to a payable as recited in claims 1, 17, and 23.

The at least one visual display, the visual display has cards represented in an n-sided closed figure (columns 89 and 90), each side of the figure is a separate hand that has five cards having three interior cards and two corner cards, the corner cards are shared with two adjacent hands, and the resulting hands are compared to a payable as recited in claim 10.

Two pairs of hand are dealt so that each hand has three interior cards and all hands share two common end cards (columns 89 and 90) as recited in claim 19.

Dealing cards in a four sided shape having 16 cards (columns 89 and 90), each side is a separate hand that has five cards having three interior cards and

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two corner cards, the corner card are shared with two adjacent hand, and paying the player according to amounts set out in the payable for each hand as recited in claim 23.

Marks et al does not expressly disclose the following:

Exchanging cards from one hand to another hand and other additional hands as recited in claims 1, 10, 17, and 23.

Exchanging corner cards but the interior cards are not exchanged as recited in claim 4.

An additional card is dealt that can be exchanged with one of the corner cards as recited in claims 6 and 14.

The swaps are limited to a predetermined number as recited in claim 27.

Wood et al teaches the following:

Exchanging cards from one hand to another hand (column 2, lines 25-54) or an additional card capable of being exchanged, in which the examiner interprets the additional card to be exchange to be the traditional exchanging of cards in poker to be an equivalent to the additional card that can be exchanged, and the swaps are limited to a predetermined number, in which the examiner interprets the number of hands played to be limited to a predetermined number as recited in claims 1, 4, 10, 14, 17, 23, and 27. By having the ability of exchanging cards or designate cards, one of ordinary skill in the art would provide game players a chance to modify their poker hands to increase their chances for a better reward.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Marks et al to include exchanging cards from one hand to another hand as taught by Wood et al to provide game players a chance to modify their poker hands to increase their chances for a better reward.

At the time the invention was made, it would have been an obvious to a person of ordinary skill in the art to designate cards that are faced up or faced down because having cards that are designated to face up or face down would provide game players with the same random chance outcome, in which Applicant has not disclosed that the three cards for each hand are dealt face up/down and the corner cards are dealt face up/down as recited in claims 2-3, 11-12, and 18 provides an advantage or solves a stated problem.

At the time the invention was made, it would have been an obvious to a person of ordinary skill in the art to display a plurality of cards in a different configuration because having cards displayed in a four, six, eight, ten, or n-sided shape provide game players with the same random chance outcome, in which Applicant has not disclosed that the different laid out card configurations as recited in claims 1, 5, 8-10, and 17 provides an advantage or solves a stated problem.

The underlying game of applicant's invention is the same as the cited prior art. The underlying game of applicant's invention is a multi-hand poker game having designated wild cards and a swapping feature to exchange with other hands to increase the chance of multiple winning poker hands. The cited prior

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art discloses a multi-hand poker game having designated wild cards and an exchange feature to trade cards from one hand to another to increase the chances of multiple winning poker hands. The only difference between the applicant's invention and the cited prior art is the different configuration types of how the cards are laid out on a display.

9. Claims 7 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marks et al. (US 5,882,260) in view of Wood et al. (US 6,471,587) as applied to claims 1 and 10 above, and further in view of Garrod (US 6,206,373).

10. Marks et al in view of Wood et al disclose the claimed invention as discussed above except for a card designated to be a wild card.

Garrod teaches a card being a wild card (summary). By having a wild card, one of ordinary skill in the art would be able to provide game players with the opportunity for an increased payout.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention was made to modify Marks et al to further include a wild card as taught by Garrod to provide game players a chance at an increased outcome.

11. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marks et al. (US 5,882,260) in view of Wood et al. (US 6,471,587) as applied to claim 10 above, and further in view of Wachtler et al. (Us 3,876,208).

12. Marks et al in view of Wood et al disclose the claimed invention as discussed above except for the player paying for each card exchange.



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Wachtler et al teaches the method of paying for each card exchanged. By paying for each card exchange, one of ordinary skill in the art would be able to provide game players with the opportunity to increase the chance of a bigger payout outcome.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Marks to further include paying for each card exchange as taught by Wachtler to provide game players an opportunity for a guaranteed payout outcome.

### *Response to Arguments*

The declaration of Tony Celona filed October 22, 2004 is insufficient to overcome the rejection of claims 1-14, 17-19, 23, and 26-27 based upon the obviousness rejection of 35 U.S.C. 103(a) as set forth in the last Office action because: The mere opinion of the Mr. Celona's commercial knowledge, business experience and success in games does not provide grounds in the determination of nonobviousness.

13. Applicant's arguments filed October 22, 2004 have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the suggestion to combine can be found in the reference of Wood et al. (US 6,471,587).

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Marks et al (US 5,882,260) disclosed all of the claimed limitations except for exchanging cards from one hand to another hand. Wood et al was used to teach the feature of exchanging cards. Applicant contends that a qualifier is needed in order for the exchanging of cards from one hand to another hand to take place. The examiner agrees with applicant, however the preamble has the word comprising. Since the word comprising is open-ended language the claims does not preclude from having a qualifier or not. Therefore, Wood et al does teach of exchanging cards from one hand to another hand to maximize the award paid to the player (summary). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Marks et al to include exchanging cards from one hand to another hand as taught by Wood et al to provide game players a chance to modify their poker hands to increase their chances for a better reward.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the game is too slow to be commercially viable, the cards are not dealt automatically, and different strategy) are not recited in the rejected claim(s). Although the claims are interpreted in light of the

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specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### *Conclusion*

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alex P. Rada whose telephone number is 571-272-4452. The examiner can normally be reached on Monday - Friday, 08:00-16:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Jessica Harrison can be reached on 571-272-4449. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
APR

JESSICA HARRISON  
PRIMARY EXAMINER

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